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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,069	05/13/1999	SHIGETAKA TANAKA	2271/59262	8608

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/15/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/317,069

Applicant(s)

TANAKA, SHIGETAKA

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2622

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on April 30, 2003, and has been entered and made of record. Currently, **claims 1-11** are pending.

Response to Arguments

2. Applicant's arguments with respect to **claims 1-11** have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2622

4. **Claim 1 and 3-11** are rejected under 35 U.S.C. 102(e) as being anticipated by Imai *et al.* (U.S. Patent Number 6,104,504).

Regarding **claim 1**, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 1, lines 9 through 55) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 8, lines 3 through 20), verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33).

Regarding **claim 3**, Imai discloses the method discussed above in claim 1, and further teaches that the optional frame include SUB, SEP, and PWD in conformance with the recommendation T-30 of ITU-T (column 1, lines 10 through 55).

Regarding *claim 4*, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using optional frame signals (column 1, lines 9 through 55) in a calling number display service mode (SEP signal included in the DTC signal, column 3, lines 22 through 58), comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), receiving a telephone number of a calling facsimile machine during a call establishing process in the calling number display service mode and a signal requesting a facsimile communications operation using an optional frame (column 6, lines 9 through 62), verifying the telephone number of the calling facsimile machine received in the receiving step with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the telephone number of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33, and column 6, lines 33 through 62).

Regarding *claim 5*, Imai discloses a facsimile apparatus (see abstract, and Fig. 1) comprising memory means (RAM 7, column 2, lines 48 through 53) for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), modem means (modem 8, column 2, lines 54 through 60) for receiving a call from a calling facsimile machine for a

Art Unit: 2622

facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 8, lines 3 through 20), and a means (CPU 1, column 2, lines 38 through 41) for verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33).

Regarding *claim 6*, Imai discloses a facsimile apparatus (see abstract, and Fig. 1) comprising memory (RAM 7, column 2, lines 48 through 53) for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), modem (modem 8, column 2, lines 54 through 60) for receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 8, lines 3 through 20), and a controller (CPU 1, column 2, lines 38 through 41) for verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification

Art Unit: 2622

information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33).

Regarding *claim 7*, Imai discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 1, lines 9 through 55) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 8, lines 3 through 20), and verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), wherein when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory, standard facsimile operations that do not use the optional frame are performed while facsimile operations that would use the optional frame are canceled (column 4, lines 34 through 43).

Regarding *claim 8*, Imai discloses the apparatus discussed above in claim 5, and further teaches that the memory means stores a table of identification information identifying facsimile

Art Unit: 2622

machines capable of operating with optional frames (column 2, lines 48 through 53, and column 8, lines 45 through 62).

Regarding *claim 9*, Imai discloses the apparatus discussed above in claim 6, and further teaches that the memory stores a table of identification information identifying facsimile machines capable of operating with optional frames (column 2, lines 48 through 53, and column 8, lines 45 through 62).

Regarding *claim 10*, Imai discloses a method for performing a facsimile communications operation using an optional frame signal (column 1, lines 9 through 55) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 3, line 48 through column 4, line 21, and column 8, lines 3 through 20), verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33).

Art Unit: 2622

Regarding *claim 11*, Imai discloses a method for performing a facsimile communications operation using optional frame signals (column 1, lines 9 through 55) in a calling number display service mode (SEP signal included in the DTC signal, column 3, lines 22 through 58), comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (variable tmp-box-no, column 4, lines 8 through 67), receiving a telephone number of a calling facsimile machine during a call establishing process in the calling number display service mode and a signal requesting a facsimile communications operation using an optional frame (column 6, lines 9 through 62), verifying the telephone number of the calling facsimile machine received in the receiving step with the identification information prestored in the memory (column 4, lines 15 through 33, column 8, lines 10 through 36), canceling performance of the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 4, lines 34 through 43), and executing the facsimile communications operation using the optional frame when the telephone number of the calling facsimile machine corresponds to the identification information prestored in the memory (column 4, lines 22 through 33, and column 6, lines 33 through 62).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Imai *et al.* (U.S. Patent Number 6,104,504) in view of Yoshida (U.S. Patent Number 5,671,270).

Regarding **claim 2**, Imai discloses the method discussed above in claim 1, but fails to specifically teach if the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine. Yoshida discloses a facsimile communication method for performing a facsimile communications operation using an optional frame signal (see abstract) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (column 6, line 50 through column 7, line 25, and column 11, lines 6 through column 12, line 64), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 11, line 39 through column 12, line 21), and verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 11, lines 6 through 16). Further, Yoshida teaches that the identification information prestored in the memory

Art Unit: 2622

comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48) and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings in the system of Imai. Imai's system would easily be modified to include Yoshida's teachings, as the systems share cumulative features, being additive in nature.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2622

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
July 11, 2003


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